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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,893	11/19/2001	Jonathan J. Hull	015358-007500US	1603

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EXAMINER

BAUTISTA, XIOMARA L

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/001,893

**Applicant(s)**

HULL ET AL.

**Examiner**

X. L. Bautista

**Art Unit**

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 16-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/9/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed January 17, 2006 have been fully considered but they are not persuasive.

A. Applicant argues, "...the 'index print' discloses by Schelling...does not read on the recited 'coversheet'...the...'index print' is an index of a set of data files stored on a digital recording medium...the recited coversheet is for 'a multimedia paper document comprising one or more pages'...Schelling 'index print' comprises images produced from data files stored on the digital recording medium, while the recited coversheet comprises a thumbnail image for each page which comprises the multimedia paper document...Schelling 'index print' does not read on the recited coversheet, and so Schelling...do not disclose or suggest a coversheet..." (page 8, last paragraph-page 9, second paragraph).

In response, claim 1 recites, generating a coversheet for a multimedia paper document comprising one or more pages, wherein a printable representation of multimedia information is printed on each page, the multimedia information comprising video information. Schelling discloses, generating an index print (coversheet) for multimedia (video, audio, images) having a plurality of index images representing still images, motion sequences and sound sequences. Claim 1 also recites, printing a thumbnail image for each page of the multimedia paper

document on a paper document on a paper medium to generate the coversheet.

Lowitz is relied upon its teaching of printing video images on a printable medium for presenting and organizing the video images, which can be printed alone and together with annotations.

B. Applicant argues, "Lowitz...was cited for teaching the printing of video images on paper...There is not motivation or need to make the asserted combination of references..." (page 9, fourth paragraph, line 1- page 10, line 4).

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Schelling teaches generating an index print for multimedia document (video, audio, images) having a plurality of index images and Lowitz teaches printing video images on a printable medium for presenting and organizing the video images, which can be printed alone or together with annotations.

The claims stand rejected as in the office action of July 13, 2005, which is incorporated herein for reference.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-4, 6, 7, 16-19, 21, 22, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schelling et al* (US 5,706,097) and *Lowitz et al* (US 5,485,554).**

Claims 1, 16 and 24:

Schelling discloses a method for identifying images and sound recordings (multimedia) on a digital recording medium. The recording medium has individually addressable digital data files containing still images, motion sequences and sound sequences, an index print (coversheet) having a plurality of index images representing the still images, motion sequences and sound sequences on the digital recording medium. Schelling teaches that the index print may be used for printing an image (thumbnail) of the document (page, index print), (abstract; col. 1, lines 58-67; col. 2, lines 1-14, 43-67; col. 4, lines 57-67; col. 5, lines 6-12). Schelling does not teach printing a thumbnail image of a page of a multimedia paper document to generate a cover sheet. However, Lowitz discloses a method and system for printing

video images on a printable medium. Lowitz teaches that the system enables users to print single frames or selected sequences or a multiplicity of video images to present and organize the video imagery which is useful for video editors, producers, and graphic artists (col. 2, lines 6-62; col. 4, lines 8-12; col. 5, lines 61-67). Lowitz teaches that the images can be analyzed (col. 8, lines 56-64) and portions of frames can be selected as printable image data, which can be printed alone or together with annotations (col. 11, lines 44-67; col. 12, lines 1-20). Therefore, it would have been obvious to one ordinarily skilled in the art at the time of inventions to modify Schelling's method of recording multimedia to include Lowitz's teaching of printing video images on paper to create a coversheet having multimedia information because it provides the user with an inexpensive way to select, enhance, and create presentations of video images on a printable medium.

Claims 2, 17 and 25:

See claim 1. Schelling teaches printing text information on the index print for each image, wherein the text information is extracted from the document information (col. 5, lines 1-5, 15-16).

Claims 3, 18 and 26:

See claim 1. Schelling teaches printing a user-selectable identifier on the index print for each image printed on the index, wherein the identifier enables user access to multimedia information (col. 4, lines 57-67; col. 5, lines 13-14).

Claims 4, 19 and 27:

See claim 1. Schelling teaches printing a matter descriptor such as a title identifying the subject matter of the data file (col. 5, lines 1-3). Lowitz teaches encoding information in barcode on the printable medium (col. 2, lines 35-48) and using identifiers (tag, mark) associated with specific frames, which can be printed together with the images if desired (col. 8, lines 24-55).

Claims 6 and 21:

See claims 2 and 3. Schelling teaches an index print having video frames extracted from video information and text information extracted from the document (col. 4, lines 57-67; col. 5, lines 13-14).

Claims 8 and 23:

See claim 1. Schelling teaches an indicator icon that indicates files containing sound and a text message describing the data file. Shelling illustrates text relating to (fig. 1) a sound recording of a person's (i.e. Grandma's) voice (col. 2, lines 62-67; col. 3, lines 10-29). Lowitz teaches that audio effect textual or iconic reference can be associated with the video image (col. 11, lines 62-67; col. 12, lines 1-20).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 5, 20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schelling/Lowitz* and *Yamaura* (US 5,857,185).**

Claims 5, 20 and 28:

Schelling teaches that index codes for addressing the digital data files containing the images are assigned and appended to the files (col. 3, lines 1-39) but it does not teach printing a frequency count for indicating the number of times that information is located on the page. However, Yamaura discloses a method and system for searching and representing search results that displays results using a display attribute that corresponds to the attribute of the string in each document. The display attribute varies in accordance with the frequency of occurrence of the searched string in each document. Yamaura teaches that the frequency of occurrence may be numerically displayed by the side of each of the listed documents (abstract; col. 1, lines 50-59; col. 2, lines 24-29; col. 3, lines 38-40; col. 4, lines 20-33, 62-67; col. 8, lines 39-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schelling/Lowitz's method for identifying images to include Yamaura's teaching of displaying



a frequency count because as Yamaura says, it is helpful information for determining which document is optimum as a result of searching among a list of documents.

**7. Claims 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schelling/Lowitz* and *Gibbon et al* (US 6,098,082).**

Claims 7 and 22:

See claim 6. Schelling does not teach that the multimedia document includes printed closed-caption text information. However, Gibbon discloses a method for providing a compressed rendition of a video program in a format suitable for electronic searching and retrieval on the WWW. Gibbon teaches pictorial transcripts that are compact representations of video programs which are automatically generated by selecting representative frames or images from the video program and combining them with a second media component such as audio or text which is associated with each representative frame (abstract; col. 1, lines 55-67; col. 2, lines 1-15; col. 3, lines 10-15). Gibbon teaches that a printed rendition of closed-captioned text may be provided. The printed rendition is a pictorial transcript in which each representative frame is printed with a caption containing the portion of the closed-caption text corresponding to the scene from which the representative frame is taken (col. 3, lines 16-22). Thus, it would have been obvious

to a person having ordinary skill in the art at the time of invention to modify Schilling/Lowitz to include Gibbon's teaching of printing closed-caption text because it provides a printable visual presentation of the sound associated with the image (frame) of interest; therefore, close captioning is not only visible on a TV receiver designed to display it but it is also visible when being printed on paper.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

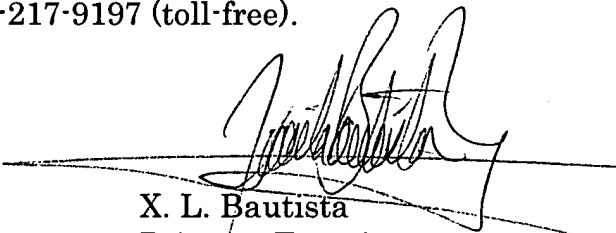
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X. L. Bautista whose telephone number is (571)

272-4132. The examiner can normally be reached on Monday-Thursday 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



X. L. Bautista  
Primary Examiner  
Art Unit 2179

xlb  
March 16, 2006